

P20637.A12

Remarks

Initially, Applicant thanks the Examiner for returning initialed copies of the Forms PTO-1449 filed on June 11, 2001 and January 3, 2002. Applicant notes that the Examiner has indicated that the file does not include copies of documents 3-8 and 10-12 and Canadian Patent Application No. 2,152,210 from the June 11, 2001 Information Disclosure Statement. In response, Applicant is hereby resubmitting copies of these documents along with a copy of the date-stamped filing receipt evidencing filing on June 11, 2001. Accordingly, Applicant submits the missing documents were timely filed, and these documents should be considered in the current case without need for a fee. The Examiner is requested to initial the appropriate spaces on the attached PTO-1449 form and to return an initialed copy of the Form to the Applicant with the next official communication in the present application to confirm consideration of these documents.

Reconsideration and withdrawal of the rejections and objections of record is respectfully requested.

Sequence Listing

Applicant submits herewith a new copy of the sequence listing to correct an inadvertent error in the previously submitted sequence listing which resulted in amino acid no. 68 of SEQ ID NO:5 being changed from Glycine to Glutamine. The Office Action noted that the originally filed sequence listing disclosed that this amino acid was Glycine. Thus, Applicant respectfully submits that this amendment does not add new matter.

Restriction Requirement

Applicant notes that the Office Action indicates that the Restriction Requirement has been maintained and made final. However, Applicant again respectfully submits that unity of invention between Groups I, II and III is present because the claimed sequences can be considered to be analogous to claims directed to a process specially adapted for the manufacture of the claimed polypeptide of Groups I, II and III. Applicant also respectfully submits that the Restriction Requirement fails to bear the burden of proving lack of unity of invention by relying on the International Search Report. Applicant notes that the ISR cites three (3) separate groups, not nine (9) as listed in the Restriction Requirement. Therefore, the restriction to nine groups is not supported by the ISR. Moreover, the claims make an inventive contribution over the prior art for the reasons set forth within.

Accordingly, it is respectfully requested that the Examiner seriously reconsider the requirement for restriction, and withdraw the same. In any event, rejoinder is requested upon allowance of the elected claims.

Summary of Status of Amendments and Office Action

In the present amendment, claims 1, 2 and 5-10 are amended and claim 12 is added. Therefore, claims 1-12 are pending in the application with claims 1, 2, 5-9, 11 and 12 being independent.

In the Office Action, the Restriction Requirement dated September 23, 2003, was deemed proper and made final.

In the Office Action, claims 1-3 and 5-8 are rejected, and claims 4 and 9-11 are withdrawn from consideration.

Claims 1-3 and 5-8 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 6 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite.

Claims 2, 5 and 7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

Claims 2 and 5-8 are rejected under 35 U.S.C. 102(b) as anticipated by Hirai (JP06293800).

Response to §101 Rejection

Claims 1-3 and 5-8 have been rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The Office Action asserts that the claims as written do not sufficiently distinguish over proteins as they exist naturally. In response, Applicant has amended claims 1, 2 and 5-10 to make clear that the claimed subject matter is “isolated” proteins. Therefore, Applicant respectfully submits that the rejection should be withdrawn.

Response to §112, Second Paragraph Rejection

Claims 6 and 8 have been rejected under 35 U.S.C. 112, second paragraph, as being indefinite. The Office Action asserts that the recitation “one or more amino acids are substituted, deleted, and/or added” is indefinite because it can have multiple meanings, and it is unclear which is intended.

In response, Applicant has amended claims 6 and 8 by removing the phrase “deleted, and/or added.” In making this amendment, Applicant does not acquiesce to the assertion made in the rejection, but is merely attempting to decrease the issues and to advance prosecution of the application for early allowance of the claims. Applicant respectfully requests that the rejection of claims 6 and 8 be withdrawn.

Response to §112, First Paragraph Rejection

Claims 2, 5 and 7 have been rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The rejection asserts that the language of claims 5 and 7 does not place any limits on the number of amino acids deleted, and therefore, the claims encompass any and/or all polypeptides comprising any and/or all single amino acids or contiguous fragments of SEQ ID NOs:1, 3 and 5. The rejection asserts that claim 2 is drawn to polypeptides having 95% homology to SEQ ID NOs:1, 3 and 5, but does not contain any particular biological activity, nor any particular conserved structure or other disclosed distinguishing feature.

In response, Applicant has amended claims 5 and 7 by removing the phrase “deleted, and/or added.” Applicant has also amended claim 2 to add the functional limitation that the claimed sequences have “an activity of enlarging mammary glands.” In making this amendment, Applicant does not acquiesce to the assertion made in the rejection, but is merely attempting to decrease the issues and to advance prosecution of the application for early allowance of the claims. Applicant respectfully requests that the rejection of claims 2, 5 and 7 be withdrawn.

Response to §102(b) Rejection

Claims 2 and 5-8 have been rejected under 35 U.S.C. 102(b) as anticipated by Hirai (JP06293800). The Office Action asserts that Hirai discloses an amino acid sequence which has 95.7% homology to SEQ ID NO:1.

In response, Applicant has amended claims 2, 6 and 8 from 95% to 98%. Claims 5 and 7 have been amended to add the limitation that the claimed protein “has 98% or more homology to the amino acid sequence disclosed in SEQ ID NOS:1, 3 or 5.” In making this amendment, Applicant does not acquiesce to the assertion made in the rejection, but is merely attempting to decrease the issues and to advance prosecution of the application for early allowance of the claims. As such, Hirai does not teach all of the limitations of the claimed invention as amended, and the rejection of claims 2 and 5-8 should be withdrawn.

CONCLUSION

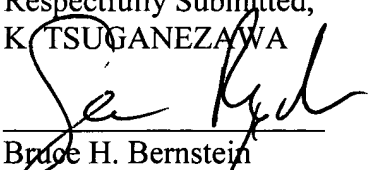
Applicants submit that the foregoing amendments traverse the rejections of record. For the reasons advanced above, it is respectfully submitted that the rejections of record should be withdrawn, and such withdrawal is respectfully requested.

Allowance of the application with an early mailing date of the Notices of Allowance and Allowability is therefore respectfully requested.

P20637.A12

Should the Examiner have any questions, please contact the undersigned at the telephone number provided below.

Respectfully Submitted,
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